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| 10/018,336 | 10/30/2001 | Bernhard Lettmann | IN-5530 | 2515 |
| 77224 7550 09/11/2008 | | | | |
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| EXAMINER | | | | |
| ASINOVSKY, OLGA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1796 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/018,336

Applicant(s)

LETTMANN, BERNHARD

Examiner

OLGA ASINOVSKY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 18, 19, 21, 22, 25, 26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 18, 19, 21, 22, 25, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The cancellation of claims 1,2, 4-17,20,23-24, 27, 29-41 is noted.

Response to Amendment

Applicant's amendment to substitute claim language containing with comprising is noted. The limitation of water content for (a23) in the amount of 10 to 89% by weight is supported in the original specification at page 75, line 16.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701.
3. Reference has been considered in the previous office action mailed on 04/02/2008 at pages 3-6. All discussions are adequately set here.

Response to Arguments

4. Applicant's arguments filed 07/08/2008 have been fully considered but they are not persuasive. The argument is that Reusmann is directed to a mixed system **consisting of**, therefore, the system is close ended, and does not allow for any additional components other than A and B, page 7/16. Applicant is referring to column 2, line 61 and column 11, line 64.

The **claimed invention in Reusmann is mixer system comprising, see claim 1 at column 16.** The language "consisting of" in the disclosure is alternative definition that the mixer system of the invention consists of plurality/**various** pigment-containing base

colors (component A) including at least one coloring and/or special effect pigment, organic solvent, at least one water-thinnable or water-dispersible first binder and, if desired, auxiliaries and additives, and at least one water-containing, pigment-free component B. The applicant's argument is not persuasive. Any additional component(s) is/are expected for obtaining the desired color, viscosity and physical characteristics of the coating composition. Applicant's argument is that Reusmann is explicit in disclosing that mixer system consists of components A and B and nothing else, and does not provide any suggestion or motivation to add a third component comprising water soluble or dispersible binder, color pigment, 10 to 89 % by weight water, page 9/16 in the remarks. Referring to the disclosure at column 12, Reusmann discloses as component B comprising 60 to 98 % by weight of water, binder and if desired, further water-thinnable or water-dispersible binders. The content of water is readable in the amended claim 3. The composition can include a binder mixture and additional water-thinnable or water-dispersible binders. Concerning present claim 22 as applicant's argument at page 10/16, Reusmann discloses water-soluble and/or water-dispersible thickeners including polyvinyl alcohol, poly(meth)acrylamide, poly(meth)acrylic acid, polyvinylpyrrolidone, styrene-maleic anhydride, column 11, lines 1-34. Therefore, pigment-free rheology module (IV) is readable in Reusmann invention.

5. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701 in view of Schwarte et al U. S. Patent 6,001,915.

6. References are considered at pages 6-7 of the office action mailed on 04/02/2008. All discussions are adequately set here.

Response to Arguments

7. Applicant's arguments filed 07/08/2008 have been fully considered but they are not persuasive. Argument is that Reusmann discloses a system consisting of components A and B, that system is closed ended and does not allow for the inclusion of any components that are not within the scope of A and B. Therefore, the combination of teaching of Reusmann and Schwarte is not proper, page 11/16.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references disclose relevant teachings of aqueous coating compositions. The additional water-dilutable/water-thinnable binder in Schwarte invention can be employed to modify water-dilutable coating composition in Reusmann invention to control the viscosity and coating property of the resulting coating composition in Reusmann invention.

8. Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al U.S. Patent 6,403,701 in view of Kawakami et al EP 0 081 994.

References have been considered at pages 7-8 in the office action mailed on 04/02/2008. All discussions are adequately set here.

Response to Arguments

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, any additional water-soluble or water-dispersible binder with pigment in water medium is expected in Reusmann invention. Both references belong to the analogous prior art. Reusmann does disclose the coating composition comprising of the ingredients for coating purposes. It would be obvious to combine the teachings of these two references for modifying an aqueous coating composition in Reusmann by employing an addition binder, conventional pigment and water by teaching in Kawakami.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLGA ASINOVSKY whose telephone number is (571)272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Olga Asinovsky
Examiner
Art Unit 1796

September 07, 2008

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796